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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,322	04/05/2001	Laurent Schaller	P0021814.00	5639

77218 7590 12/09/2010  
Medtronic CardioVascular  
Mounds View Facility South  
8200 Coral Sea Street N.E.  
Mounds View, MN 55112

EXAMINER
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PATEL, NIHIR B

ART UNIT	PAPER NUMBER
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3772

NOTIFICATION DATE	DELIVERY MODE
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12/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/828,322	<b>Applicant(s)</b> SCHALLER ET AL.	
	<b>Examiner</b> NIHIR PATEL	<b>Art Unit</b> 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on applicant's remarks filed on 09/27/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5-19,21-23,31-38,45,46,52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-19,21-23,36-38,45,46,52 and 53 is/are allowed.
- 6) ☒ Claim(s) 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/04/2010</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on September 27<sup>th</sup>, 2010, with respect to claims 5-19, 21-23, 31-38, 45, 46, 52 and 53 have been fully considered and are persuasive. The previous rejection(s) of the office action dated May 27<sup>th</sup>, 2010 has been withdrawn.

### ***Allowable Subject Matter***

2. Claims **5-19, 21-23, 36-38, 45, 46, 52 and 53** are allowed. In reference to claims 5-19, the prior art does not disclose each clip has a proximal end point and a distal end point and wherein the proximal end point is separated from the distal end point when the clip is in the open configuration and wherein the distance between the proximal end point and the distal end point is reduced when the clip is in the closed configuration. In reference to claims 21-23, the prior art does not disclose a coil surrounding a substantial length of the self-closing clip, where the coil is coupled at one point on the self-closing clip releasably coupled via the release mechanism at a second point on the self closing slip. In reference to claims 36-38, the prior art does not disclose tissue piercing members in combination with a pair of coils surrounding at least a portion of the elongated member, the pair of coils being serially arranged and spaced from one another along the elongated member. In reference to claims 45, 46, 52 and 53, the prior art does not disclose a pair of coils, one of the coils surrounding at least a portion of one of the first loop portion and the other of the coils surrounding at least a portion of the second loop shaped portion.

3. The indicated allowability of claims 31-35 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims **31-35** are rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 5,941,888).

6. **As to claim 31**, Wallace teaches a surgical clip apparatus comprising an elongated member **106 (see fig. 1; col. 5 lines 55-60)**, a pair of coils **102 and 104 (see fig. 1; col. 4 lines 50-60)** surrounding at least a portion of the elongated member (**see fig. 1**), the pair of coils being serially arranged and spaced from one another along the elongated member (**see figure 1; col. 5 lines 55-65**), the elongated member being shape memory material and having an unbiased shape, which includes a plurality of loops and a biased shape, the elongated member tending to move toward the unbiased shape from the biased shape (**fig. 1; col. 5 lines 55-67 and col. 6 lines 1-5**).

7. **As to claim 32**, Wallace teaches a surgical clip apparatus wherein the loops are spaced from one another (**see figs. 1 and 5**).

8. **As to claim 33**, Wallace teaches a surgical clip apparatus wherein each coil surrounds at least a portion of a different one of the loops (**fig. 1; col. 5 lines 55-67 and col. 6 lines 1-5**).

9. **As to claim 34**, Wallace teaches a surgical clip apparatus wherein each coil has an outer end and an inner end, the inner ends being spaced from one another (**see figs. 1 and 5**).

10. **As to claim 35**, Wallace teaches a surgical clip apparatus wherein each coil has an outer end and an inner end (**see figs. 1 and 5**), and the elongated member has two enlarged end

Art Unit: 3772

portions **108 and 110 (see fig. 1; col. 7 lines 45-60)**, further including a restraint coupled to the elongated member adjacent to each of the inner ends.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIHIR PATEL whose telephone number is (571)272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nihir Patel/  
Examiner, Art Unit 3772

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772

Application/Control Number: 09/828,322

Page 5

Art Unit: 3772